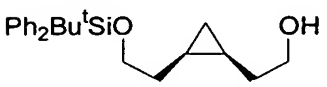
REMARKS

Claims 1, 4, 5, and 8 – 10 are pending.

The §112 Rejection

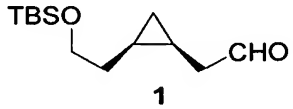
Claims 1 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner asserts that the Specification "fails to provide teachings to show how to make the claimed compounds wherein the moiety C being cyclopropane."

In response, Applicants note that the Specification clearly discloses how to make the claimed compounds where the moiety C is an oxirane. One skilled in the art would know how to make the corresponding compounds where the moiety C is cyclopropyl by simply substituting a cyclopropyl analog for one of the reactants or intermediates in the synthesis scheme described in the present specification in Example 3 (page 17). Such cyclopropyl analogs are known or can readily be prepared by those skilled in the art. See, for example, U.S. 6,552,084, which discloses compound **126** in Example 14 (Col. 30 – 32). One skilled in the art would recognize that the only difference between the cyclopropane analog (**1**) of compound **20** (which is one of the reactants in Example 3 of the present Specification) and compound **126** of the '084 reference is an alcohol-for-aldehyde substitution and a trivial change in substituents on silicon (that is, a slightly different protecting group is used for compound **126** of the '084 reference than for compound **20** of the present Specification). One skilled in the art would realize that the silicon protecting group change could be effected merely by switching from using *t*-butyldiphenylsilyl chloride in Example 14 of the '084 reference to using *t*-butyldimethylsilyl chloride, and the aldehyde of compound **1** could be readily produced by oxidizing the alcohol of compound **126** using, for example, Swern's conditions (dimethyl sulfoxide, oxalyl chloride, triethylamine, -78 °C).



126

20



1

Additionally, Applicants direct the Examiner's attention to Falck, *et al.*, *Bioorganic and Medicinal Chemistry Letters* **2003**, volume 13, pages 4011-4014, which discloses a

cyclopropyl compound encompassed within the structure recited in Applicants' claims. This paper provides evidence that those skilled in the art indeed know how to make the cyclopropyl compounds recited in Applicants' present claims. See compound **13** in table 1 of Falck, et al., which is a compound encompassed within the structure recited in present Claim 1, wherein: R1 is CO2R, R is H, A is CH2CH2 (a C2 alkyl group), B is CH=CH (a C2 alkenyl group), C is cyclopropyl, D is CH2CH2CH2 (a C3 alkyl group), and X-Y is *n*-C5H11.

The Double Patenting Rejection

Claims 5 and 8 – 10 are rejected under 35 U.S.C. 101 as claiming the same invention as that of Claims 5 – 12 of prior U.S. Patent No. 6,750,250B1 (Belanger, et al.).

Applicants have amended Claims 5 and 8 – 10 to overcome this rejection. Specifically, Claims 5 and 10 have been amended so that the substituent "C" is defined to be "cyclopropyl".

Applicants believe that the above amendments and remarks have placed Claims 1, 4, 5, and 8 - 10 in condition for allowance. Accordingly, allowance of the claim in this application is respectfully requested.

Respectfully submitted,

ALCON

3/9/05
Date

Patrick M. Ryan
Reg. No. 36,263

ADDRESS FOR CORRESPONDENCE:
Alcon Research, Ltd.
R&D Counsel Q-148
6201 South Freeway
Fort Worth, TX 76134-2099
(817) 551-3066
Docket No. 2140A